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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,136	05/06/2004	Antonio Cardoso	CRUZ/002	7257
26291	7590	06/14/2006	EXAMINER	
PATTERSON & SHERIDAN L.L.P. 595 SHREWSBURY AVE, STE 100 FIRST FLOOR SHREWSBURY, NJ 07702				CHUKWURAH, NATHANIEL C
ART UNIT		PAPER NUMBER		
				3721

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/840,136	CARDOSO, ANTONIO
	Examiner Nathaniel C. Chukwurah	Art Unit 3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 March 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 and 23 is/are rejected.
- 7) Claim(s) 24-29 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 May 2004 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. This action is in response to applicant's amendment received on 3/31/2006.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8-13, 15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell et al. (US 5,375,664) in view of Roynestad (US 6,047,771).

With regard to claim 1, McDowell et al. discloses an attachment comprising: a lead (30), a hammer (38) slidably coupled to the lead; a lead mounting assembly (20, 26, 31) pivotally coupled to the lead, and having a mounting arrangement as shown with hydraulic actuator (34) configured to allow rotation of the lead in a plane; a hydraulic actuator (36) coupled to the lead (30) and the lead mounting assembly (20, 26, 31).

McDowell et al. discloses all claimed subject matter but lack specific teaching of the actuator (36) adapted to control the pivotal orientation of the lead relative to the lead mounting assembly (20, 26, 31) in a second plane that is different than the first plane.

However, Roynestad teaches actuator (23) adapted to control the pivotal orientation of the lead (16) relative to the lead mounting assembly (16' attachment frame, 17) in a second plane (plane intersecting first axis of rotation) that is different than the first plane (plane parallel to first axis of rotation), to do work.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the lead mounting assembly of McDowell et al. by providing the actuator to orient the lead relative to the lead mounting assembly in a second plan as taught by Roynestad in order to position the lead in different position to do work.

With regard to claim 2, McDowell et al. shows a winch (46) coupled to the lead mounting assembly.

With regard to claim 3, McDowell et al. shows a first mounting hole (see hole at 31) substantially perpendicular to the lead (30).

With regard to claim 4, McDowell et al. shows the center line of the hole (see hole at 31) perpendicular to an axis of rotation of the lead (30) relative to the lead mounting assembly.

With regard to claim 5, McDowell et al. shows a mounting bracket (26) having a first hole (28) for coupling to a boom (20) and a second mounting hole (see hole adjacent 28) for coupling hydraulic actuator (34) adapted to rotate the mounting bracket (26) relative to the boom and an axis of rotation defined by the first hole.

With regard to claim 6, McDowell et al. shows a mounting plate (portion extending midway of 26) mounting bracket (26), and a shaft (see shaft coupling 31 and 26), the shaft is coaxial with an axis of rotation of the lead relative to the mounting plate.

With regard to claim 8, McDowell et al. shows a cage (hammer housing) shielding the hammer and adapted to travel with the hammer.

With regard to claim 9, the attachment of McDowell et al. meets all of applicant claimed subject matter but lacks the specific teaching of the cage comprising an integral ladder. However such feature is an engineering design choice which would have been obvious to one of ordinary

skill in the art as a matter of engineering design choice to include a ladder to the cage since applicant has not disclosed that having an integral ladder solves any stated problem and it appears that the hammer would perform equally well without the integral ladder.

With regard to claim 10, McDowell et al. discloses a lead (30), a hammer (38) slidably coupled to the lead, a lead mounting assembly (20, 26, 36) coupling the lead to the boom (20), and having a first boom mounting hole (see hole adjacent 28) defining a first axis of rotation substantially perpendicular to the lead (30); the lead (30) also rotates at (31).

McDowell et al. discloses all claimed subject matter but lack specific teaching of the lead being relational relative to the lead mounting assembly about a second axis of rotation substantially perpendicular to the first axis of rotation.

However, Roynestad teaches a lead (16) which is rotational by the actuator (23, 23') relative to the lead mounting assembly (16' attachment frame) in a second axis of rotation substantially perpendicular the first axis of rotation to do work.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to provide the lead mounting assembly of McDowell et al. with such rotation about a second axis substantially perpendicular to the first axis of rotation as taught by Roynestad in order to have the advantage of moving the lead in different positions to do work.

With regard to claim 11, McDowell et al. shows a hydraulic actuator (36) coupled to the lead (30) and the lead mounting assembly (20, 26, 36), the actuator causes the lead to rotate relative the mounting assembly. Further, the actuator is capable of being coupled the existing hydraulic fluid control port of the excavator.

With regard to claim 12, McDowell et al. shows a winch coupled to boom (20).

With regard to claim 13, McDowell et al. shows a mounting bracket (26) having a first boom mounting hole (see hole at 28); a mounting plate (portion extending midway of 26) coupled to the mounting bracket (26), and a shaft (see shaft coupling 31 and 26), the shaft is coaxial with an axis of rotation of the lead relative to the mounting plate.

With regard to claim 15, McDowell et al. shows a cage (hammer housing) shielding the hammer and adapted to travel with the hammer.

With regard to claim 23, McDowell et al. discloses an attachment comprising: a lead (30), a hammer (38) slidably coupled to the lead, a lead mounting assembly (20, 26, 36) coupling the lead to the boom (20), and configured to allow positioning of the lead (30) in two planes relative to the boom (20).

4. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell et al. in view of Roynestad as applied to claims 1 and 10 and further in view of Doty (US 4,333,541).

With regard to claims 7 and 14, the modified lead mounting assembly of McDowell et al. discloses all claimed subject matter but lack specific teaching of plurality of holes formed in the lead and adapted to accept a pin for limiting the travel of the hammer.

However, Doty teaches holes (29) for engaging pins (33) in order to limit adjustability to the overall positioning of the channel relative to the side plate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the attachment of modified lead mounting assembly of McDowell et al. with

holes as taught by Doty in order to give limiting adjustability to the overall positioning of the channel relative to the side plate. See (col. 3, lines 2-3).

***Allowable Subject Matter***

5. Claims 24-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior arts of record fail disclose an attachment, wherein the lead mounting assembly further comprises: a mounting plate pivotably coupled to the lead and having at least one curved surface captured by a tab extending from the lead.

The prior arts of record fail disclose an attachment, wherein the lead mounting assembly further comprises: a retainer securing an outer portion of the mounting plate to the lead while allowing rotation between the mounting plate and the lead.

The prior arts of record fail disclose an attachment further comprises: a second boom mounting hole having a centerline parallel to the first axis of rotation and disposed on an opposite side of the second axis of rotation relative to the first boom mounting hole.

***Response to Arguments***

6. Applicant's arguments filed 3/31/2006 have been fully considered but they are not persuasive.

With respect to claims 1-6, 8-13, 15 and 23, applicant argues that McDowell and Roynestad cannot be meaningfully combine because there is no motivation to combine the two references.

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reference of Roynestad was used to teach the advantage of orienting the lead in different position by the hydraulic cylinders (23, 23') which also would benefit the reference lead of McDowell et al. which when incorporated to the lead mounting assembly will have the ability to be positioned in different orientation to perform work.

With respect to claim 7 and 14, applicant argues that Doty fails to teach, show or suggest claim 1.

The Examiner contends that Doty was only used to teach a plurality of holes formed on a lead for limiting hammer travel. Adjusting the height of the lead at different holes limits the hammer travel.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

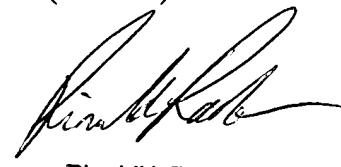
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is (571) 272-4457. The examiner can normally be reached on M-F 6:00AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NC

June 2, 2006.



Rinaldi I. Rada  
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